



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

JJGJr.: 05-05

Paper No. ____

GARLICK HARRISON
& MARKISON LLP
P.O. BOX 160727
AUSTIN TX 78716-0727

FAX RECEIVED

MAY 26 2005

OFFICE OF PETITIONS

In re Application of :
Berman, et al. :
Application No. 09/928,622 :
Filed: 13 August, 2001 :
Attorney Docket No.: BP1520 :

DECISION
ON PETITION

This is a decision on the petition under 37 C.F.R. §1.78(a)(3) and (a)(6), filed 23 August, 2004, to accept an unintentionally delayed claim under 35 U.S.C. §120 and 35 U.S.C. §119(e) for the benefit of priority to, respectively, a prior filed:

- nonprovisional application (09/886,859, filed 21 June, 2001); and
- provisional application (Application No. 60/213,140, filed 22 June, 2000).

The petition is **GRANTED**.

A review of the file record fails to disclose that a claim for the benefit of priority to the above-noted, prior-filed:

- nonprovisional application was made within the time period set forth in 37 C.F.R. §1.78(a)(2)(ii) and further failed to include a proper reference to the above-noted, prior-filed application as required by 37 C.F.R. §1.78(a)(2)(i) and §1.78(a)(2)(iii); and
- provisional application was made within the time period set forth in 37 C.F.R. §1.78(a)(5)(ii) and further failed to include a proper reference to the above-noted, prior-filed application as required by 37 C.F.R. §1.78(a)(5)(i) and §1.78(a)(5)(iii).

The instant application was filed on 13 August, 2001. Therefore, since this application was filed after November 29, 2000, a petition under 37 C.F.R. §1.78(a)(3) and (a)(6) is the appropriate avenue of relief to accept a late claim for the benefit of priority to a prior-filed nonprovisional application and a prior-filed provisional application, respectively.

A petition for acceptance of a claim for late priority under 37 C.F.R. §1.78(a)(3) and(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 C.F.R. §1.78(a)(2)(ii) and §1.78(a)(5)(ii).

The petition under 37 C.F.R. §1.78(a)(3) must be accompanied by:

- the reference required by 35 U.S.C. §120 and 37 C.F.R. §1.78(a)(2)(i) of the prior-filed application, unless previously submitted;¹
- the surcharge set forth in §1.17(t); and
- a statement that the entire delay between the date the claim was due under 37 C.F.R. §1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The petition under 37 C.F.R. §1.78(a)(6) must be accompanied by:

- the reference required by 35 U.S.C. §119(e) and 37 C.F.R. §1.78(a)(5)(i) of the prior-filed application, unless previously submitted;²
- the surcharge set forth in §1.17(t); and
- a statement that the entire delay between the date the claim was due under 37 C.F.R. §1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The granting of a petition to accept the delayed benefit claim to the prior-filed application(s) under 37 C.F.R. §1.78(a)(3) and (a)(6) should not be construed as meaning that the instant application is entitled to the benefit of the prior-filed application(s). In order for the instant application to be entitled to the benefit of the prior-filed application(s), all other requirements under the statute and regulation must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision includes the prior-filed application(s) should not be construed as meaning that the applicant is entitled to the claim for benefit of priority to the prior-filed applications noted thereon. Accordingly the Examiner will, in due course, consider this benefit claim and determine whether the instant application is entitled to the benefit of the earlier filing date.

A corrected Filing Receipt, which includes the priority claim to the above-noted, prior-filed applications, accompanies this decision on petition.

This matter is being referred to Technology Center 2100 for further processing in due course.

Inquiries concerning this decision may be directed to John Gillon, Senior Attorney, Office of Petitions at (571) 272-3214.

Frances Hicks

Frances Hicks
Petitions Examiner
Office of Petitions

Encl.: Corrected Filing Receipt

¹ Any nonprovisional application or international application designating the United States of America claiming the benefit of one or more prior-filed copending applications or international applications designating the United States of America must contain or be amended to contain a reference (amendment to the first line of the specification following the title or in an application data sheet (ADS) to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date filing date and indicating the relationship of the applications. Cross references to other related applications may be made when appropriate (*see* § 1.14).

² See: Fn. 1.